



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/331,829	06/23/1999	HIROSHI SUZUKI	1576.77	2131

7590

12/03/2001

Joseph C Mason Jr.
Mason & Associates
17757 US Highway 19 North
Suite 500
Clearwater, FL 33764

EXAMINER

SELLERS, ROBERT E

ART UNIT

PAPER NUMBER

1712

DATE MAILED: 12/03/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/331,829

Applicant(s)

SUZUKI ET AL.

Examiner

Robert Sellers

Art Unit

1712

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.
- NOTE: _____
3. ☐ Applicant's reply has overcome the following rejection(s): _____
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See the attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____
- Claim(s) objected to: _____
- Claim(s) rejected: 1-3 and 5.
- Claim(s) withdrawn from consideration: _____
8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

Robert Sellers
Primary Examiner
Art Unit: 1712

The 35 U.S.C. 112, second paragraph, rejection is rescinded in response to the adoption of the suggested amendments to claim 2 as well as pages 6, 7 and 12 of the specification espoused on page 3, the second and third paragraphs of the Final rejection mailed June 2, 2001 (Paper No. 15).

The evidence presented in Table 1 on page 6 of the amendment after Final filed September 21, 2001 (Paper No. 16) is inconclusive since the Sample Nos. 53, 50 and 48 containing 1,1-bis(4-hydroxyphenyl)cyclohexane (specification, page 26, BHC and page 28, Table 3) are not reflective of the closest prior art clathrate of bisphenol S and bisphenol A exemplified on page 15 of the Japanese patent (Host compounds (2) and (14)). Although Sample No. 54 contains 2-methylimidazole and bisphenol A in a 1:1 ratio, any difference in results could be attributable to the different curing agent. The accelerator:clathrate ratio of 2:1 in Sample Nos. 32 and 24 (specification, page 24, Table 1 and page 25, Table 2) as well as the diverse type of curing agent or accelerator in Sample Nos. 24 and 10 (2-ethyl-4-methylimidazole in Sample No. 24 versus ethylenediamine in Sample No. 10) could be responsible for the diverse pot lives.

Valid comparisons wherein the types of curing agent or accelerator and ratio of curing agent or accelerator:clathrate are held constant to isolate the effect of the kind of clathrate reside in Sample No. 49 of Table 3 of the specification reflective of the closest prior art versus Sample Nos. 10 and 11 representative of the claims wherein a 1:1 ratio of ethylenediamine:clathrate is employed (page 35, Table 6; bisphenol A versus 1,1,2,2-tetrakis(4-hydroxyphenyl)ethane or 1,1,2,2-tetrakis(3-methyl-4-hydroxyphenyl)ethane).

Art Unit: 1712


The showings with respect to the valid comparison of Sample No. 49 representative of the closest prior art versus Sample Nos. 10 and 11 reflective of the claims (page 35, Table 6) are not commensurate with the claims regarding a sampling of the claimed molar ratio of clathrate:epoxy group of from 0.001:1 to 0.1:1. The molar ratio of the tested samples are not revealed in Comparative Example 5 on page 34) to indicate whether they fall within the claimed molar ratio range.

The data is of no moment to the 35 U.S.C. 103(a) rejection regarding Japanese '570 and Asai et al. relying on the teachings of Japanese '711 wherein the issue is not the type of clathrate, but the ultimate intended utility of the clathrate of the former patents as an epoxy resin curative.

Japanese Patent No. 5-194711 on page 10, paragraph 9, states that there is no particular limitation as to the species of clathrate, thereby embracing the tetrakisphenol of Japanese Patent No. 6-329570 and Asai et al. The motivations for employing the tetrakisphenol of Japanese '570 and Asai et al. as the clathrate of Japanese '711 is clearly elucidated in the former references in order to enhance the chemical stability, ease the release of the epoxy-reactive compound by heating and lowering the toxicity of the epoxy-reactive compound (Japanese '570, Patent Abstracts of Japan, the Purpose section and the Derwent abstract, the Use/Advantage section; and Asai et al., col. 14, items 1), 5) and 7)).

(703) 308-2399 (Fax no. (703) 872-9311) Monday to Friday, 9:15 to 5:45)

RS 11/28/01



ROBERT E.L. SELLERS
PRIMARY EXAMINER